

Remarks

The examiner requested election of species under 35 U.S.C. § 121 to a single disclosed species within each of items (A) the alkenyl-radical containing polyorganosiloxanes, (B) the organohydrogensiloxanes, the pretreatment of the silver particles with either (i) alkoxysilanes or (ii) organosiloxanes, (D) the platinum catalysts, (E) the presence or absence of the siloxy-containing organosilicone compounds, wherein if its presence is elected, a particular species thereof is identified, and (F) the cure inhibitors.

The Applicants respectfully traverse the election requirement as the Examiner has failed to demonstrate either of the criteria necessary for a proper election of species requirement. MPEP §803 sets forth the following two criteria for a proper requirement for election between patentably distinct inventions:

- (1) The inventions must be independent . . . or distinct as claimed . . . ; and
- (2) There must be a serious burden on the examiner if restriction is not required.

The Examiner failed to satisfy criterion (1) because the Examiner has not given any reasons for the contention that the application contains claims to patentably distinct inventions under 35 U.S.C. §121, as required by MPEP §816. The Examiner made no statements as to the alleged independence or distinctness of the claimed invention. Therefore, the Examiner failed to meet criterion (1) by failing to demonstrate the independence or distinctness of the invention as claimed.

The Examiner failed to satisfy criterion (2) because the Examiner requested election for each of the 6 species in the composition of claim 1. Patentability searches for each group would have to be repeated if the election were limited as the Examiner required. Therefore, rather than avoiding a serious burden by issuing the present election of species requirement, the Examiner is creating a serious burden on the Patent Office via unnecessary duplication of searching effort because searches would have to be repeated many times, for each of the species named in the application. An important advantage of pursuing just one application and searching all claims together is that the examination work of the Patent Office would thereby be simplified inasmuch as duplication of search effort would be eliminated. By avoiding such duplication of search effort, the Patent Office saves time and expense.

However, if the Examiner should make this requirement final, the Applicants provisionally elect the following species. The Applicants do not elect the same species in the parent application; the Applicants draw the Examiner's attention to ingredient (C).

(A) a mixture of dimethylvinylsiloxyl-endblocked polydimethylsiloxane and organosiloxane resin containing trimethylsiloxyl, dimethylvinylsiloxyl, and $\text{SiO}_{4/2}$ units, as described at paragraphs [0051] to [0053] and Example 4 at paragraph [0107];

(B) trimethylsiloxyl-endblocked polymethylhydrogensiloxane, as described at paragraphs [0054] to [0069] and Example 4 at paragraph [0107];

(C) silver flake treated by a silanol-endblocked dimethylsiloxane oligomer, as described at paragraphs [0023] to [0039], particularly paragraph [0028];

(D) chloroplatinic acid/vinylsiloxane complex, as described at paragraphs [0070] to [0071] and Example 4 at paragraph [0107];

(E) the presence of the organosilicon compound containing at least one silicon-bonded alkoxy group per molecule as described at paragraphs [0072] to [0075], said compound of the formula depicted in Example 9; and

(F) phenyl butynol as described at paragraph [0076], and Example 4 at paragraph [0107].

Claims 1, 3, and 7-15 embrace the elected species. The Applicants make this election with traverse for the reasons discussed above. Support for new claim 7 may be found at paragraphs [0051], [0052], and example 4 at paragraph [0107]. Support for new claim 8 may be found at paragraph [0058]. Support for new claim 9 may be found at paragraphs [0062]-[0063]. Support for new claim 10 may be found at paragraph [0070]. Support for new claim 11 may be found at paragraphs [0072] and [0073]. Support for new claim 12 may be found at paragraphs [0074] and [0075]. Support for new claim 13 may be found at paragraph [0076]. Support for new claim 14 may be found at paragraph [0078]. Support for new claim 15 may be found at paragraph [0085].

The examiner objected to the specification because the Examiner argues that the status of the parent applications cited on page 1, paragraph 1 should be updated. New paragraph [0001] has been added to update the status as the examiner suggested. Therefore, the applicants request that the objection to the specification be withdrawn.

The Examiner rejected claims 1, 2, 4, and 6 under the judicially created doctrine of obviousness type double patenting over claims 1-9 of U.S. Patent No. 6,797,772. Claim 1 of this application has been amended to be distinct from claims 1-9 of U.S. Patent No. 6,797,772. U.S. Patent No. 6,797,772 does not claim treating an electrically conductive filler with a silanol endblocked siloxane oligomer, such as a silanol endblocked dimethylsiloxane oligomer, a silanol endblocked dimethylsiloxane/methylvinylsiloxane co-oligomer, a silanol endblocked methylvinylsiloxane oligomer,

or a silanol endblocked methylphenylsiloxane oligomer. Therefore, the Applicants respectfully request that the rejection over U.S. Patent No. 6,797,772 be withdrawn.

The Examiner rejected claims 1, 2, 4, and 6 under the judicially created doctrine of obviousness type double patenting over claims 1-4, 6, 8, 13, 15, 20, and 22 of U.S. Patent 6,017,587 to Kleyer in view of U.S. Patent 5,344,593 to Chiba and U.S. Patent 4,801,445 to Fukui and JP 1,249880. Claim 1 of this application has been amended to be distinct from claims 1-4, 6, 8, 13, 15, 20, and 22 of U.S. Patent 6,017,587 to Kleyer in view of U.S. Patent 5,344,593 to Chiba and U.S. Patent 4,801,445 to Fukui and JP 1,249880. None of these references discloses treating an electrically conductive filler with a silanol endblocked siloxane oligomer, such as a silanol endblocked dimethylsiloxane oligomer, a silanol endblocked dimethylsiloxane/methylvinylsiloxane co-oligomer, a silanol endblocked methylvinylsiloxane oligomer, or a silanol endblocked methylphenylsiloxane oligomer. Therefore, the Applicants respectfully request that the rejection over U.S. Patent 6,017,587 to Kleyer in view of U.S. Patent 5,344,593 to Chiba and U.S. Patent 4,801,445 to Fukui and JP 1,249880 be withdrawn.

The Examiner rejected claims 1, 2, 4, and 6 under the judicially created doctrine of obviousness type double patenting over claims 1-25 of U.S. Patent 5,804,631 to Mine in view of Fukui and Japanese '880 and U.S. Patent 5,075,038 to Cole and Japanese Patent 4-46962. None of these references discloses treating an electrically conductive filler with a silanol endblocked siloxane oligomer, such as a silanol endblocked dimethylsiloxane oligomer, a silanol endblocked dimethylsiloxane/methylvinylsiloxane co-oligomer, a silanol endblocked methylvinylsiloxane oligomer, or a silanol endblocked methylphenylsiloxane oligomer. Therefore, the Applicants respectfully request that the rejection over U.S. Patent 5,804,631 to Mine in view of Fukui and Japanese '880 and U.S. Patent 5,075,038 to Cole and Japanese Patent 4-46962 be withdrawn.

The Examiner rejected claims 1, 2, 4, and 6 under the judicially created doctrine of obviousness type double patenting over claims 1-4 U.S. Patent 5,872,170 to Mine in view of Fukui and U.S. Patent 5,075,038 to Cole and Japanese Patent 4-46962. None of these references discloses treating an electrically conductive filler with a silanol endblocked siloxane oligomer, such as a silanol endblocked dimethylsiloxane oligomer, a silanol endblocked dimethylsiloxane/methylvinylsiloxane co-oligomer, a silanol endblocked methylvinylsiloxane oligomer, or a silanol endblocked methylphenylsiloxane oligomer. Therefore, the Applicants respectfully request that the rejection over U.S. Patent 5,872,170 to Mine in view of Fukui and U.S. Patent 5,075,038 to Cole and Japanese Patent 4-46962 be withdrawn.

The examiner rejected claims 1, 2, 4, and 6 under 35 U.S.C. §103(a) as being unpatentable over Chiba, U.S. Patent 5,384,075 to Okami, and U.S. Patent 5,173,765 to Nakayoshi in view of Fukui and

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Japanese '880 because Chiba discloses a formulation containing 100 parts by weight of vinyl-group containing polydimethylsiloxane, 5 to 50 parts by weight of a hydrosilyl group containing polydimethylsiloxane, 30 to 1000 parts by weight of electroconductive particles, an amount effective to cure the formulation of a platinum curing catalyst, and a hydrosilylation reaction controlling agent. The Examiner further argues that Okami discloses a composition prepared from 100 parts by weight of an alkenyl group containing organopolysiloxane, an organohydrogensiloxane having from 0.6 to 6.0 silicon bonded hydrogen atoms per alkenyl group, a platinum catalyst, 0.5 to 20 parts by weight of an alkoxy-group containing organosilicon compound, an electrically conductive filler such as silver powder, and an addition reaction controlling agent. The Examiner further argues that Nakayoshi discloses a mixture of 100 parts by weight of an alkenyl-group containing organopolysiloxane, an organohydrogenpolysiloxane with from 0.5-3 silicon bonded hydrogen atoms per alkenyl groups, up to 10 parts by weight of an alkoxy group containing organosilicon compound, a catalytic quantity of a platinum catalyst, and from 50-2000 parts by weight of a conductive filler such as silver micropowder. The Examiner admits that Nakayoshi does not recite the claimed cure inhibitor. The Examiner argues it would have been obvious to employ the hydrosilylation reaction controlling agent of Chiba or Okami in the mixture of Nakayoshi to regulate the cure rate.

The Examiner admits that Nakayoshi, Chiba, and Okami fail to disclose the treatment of silver particles with an alkoxysilane or organosiloxane. The Examiner further argues that Fukui discloses the treatment of metals such as silver with a silicone compound. The Examiner further argues that Japanese '880 discloses the absorption of a silane coupling agent or alkoxysilane onto silver electrically conductive particles to enhance the tolerance to cold and humidity. The Examiner concludes it would have been obvious to treat the silver particles of Chiba, Okami, and Nakayoshi with the compound of Fukui or Japanese '880.

To properly conclude that a claimed invention is obvious under 35 U.S.C. §103, the decision maker must step back in time into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made. In light of all the evidence, the decision maker must then determine whether the claimed invention as a whole would have been obvious at that time to that person¹. Four factual inquiries are to be considered for determining obviousness, as follows: (A) determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art

¹ *In re Fine*, 837 F.2d 1071, 1073; 1988 U.S. App. LEXIS 686; 5 U.S.P.Q.2d (BNA) 1596 (1988).
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and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations².

A prima facie case of obviousness under 35 U.S.C. §103 requires a showing of some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art that would lead the person to combine the relevant teachings of the references³. Obviousness rejections are precluded based on a combination of teachings of references from nonanalogous arts⁴. The determination that a reference is nonanalogous is two-fold⁵. First, it must be determined whether the reference is within the field of the inventor's endeavor⁶. If not, it must be determined whether the reference is reasonably pertinent to the particular problem the inventor was trying to solve⁷.

Fukui discloses a modified powder or particulate material having a silicone polymer film coated on substantially the entire surface thereof⁸. The modified powder is used in cosmetics, pharmaceuticals, coating materials, inks, paints, decoratives, fragrances, magnetic materials, and medical materials. The problem to be solved by Fukui is to prevent the modified powder from denaturing or decomposing perfumes, oils, or resins and therefore not cause problems such as denaturization, odor change, and color change⁹.

The field of this invention relates to an electrically conductive curable organosiloxane composition¹⁰. The problem to be solved is to provide compositions yielding cured electrically conductive elastomers that retain their electrical properties for extended periods of time¹¹. This invention and Fukui are not within the same field of endeavor because Fukui discloses a modified powder for use in cosmetics, pharmaceuticals, coating materials, inks, paints, decoratives, fragrances,

² *Graham v. John Deere*, 383 U.S. 1; 86 S. Ct. 684; 15 L. Ed. 2d 545; 1966 U.S. LEXIS 2908; 148 U.S.P.Q. (BNA) 459 (1966), and MPEP §2141.

³ *In re Fine*, 837 F.2d 1071, 1074; 1988 U.S. App. LEXIS 686; 5 U.S.P.Q.2d (BNA) 1596 (1988).

⁴ *In the Matter of the Application of Wood and Eversole*, 599 F.2d 1032, 1036; 1979 CCPA LEXIS 243; 202 U.S.P.Q. (BNA) 171 (1979). See also MPEP §2141.01(a).

⁵ Id.

⁶ Id.

⁷ Id. See also MPEP §2141.01(a) and MPEP §2145 (III). A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. The claimed combination (of references) cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.

⁸ U.S. Patent 4,801,445 col. 1, lines 7-10.

⁹ Id. at col. 1, lines 28-35.

¹⁰ Paragraph [0002].

¹¹ Id.

magnetic materials, and medical materials¹², and this invention relates to an electrically conductive curable organosiloxane composition¹³. Furthermore, this invention and Fukui are not pertinent to the same problem because the problem to be solved by Fukui is to prevent the modified powder from denaturing or decomposing perfumes, oils, or resins and therefore not cause problems such as denaturization, odor change, and color change¹⁴, and the problem to be solved by this invention is to provide compositions yielding cured electrically conductive elastomers that retain their electrical properties for extended periods of time¹⁵. Therefore, Fukui is not properly cited because this invention and Fukui are not within the same field of endeavor and not pertinent to solving the same problem.

The situation with this invention is similar to that in *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992) (Clay). Claims were directed to a process for storing a refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port wherein a gelled solution filled the tank's dead volume to prevent loss of stored product while preventing contamination. One of the references relied upon disclosed a process for reducing the permeability of natural underground hydrocarbon bearing formations using a gel similar to that of applicant to improve oil production. The court disagreed with the argument that the reference and claimed inventions were part of the same endeavor, "maximizing withdrawal of petroleum stored in petroleum reserves," and found that the inventions involved different fields of endeavor since the reference taught the use of the gel in a different structure for a different purpose under different temperature and pressure conditions, and since the application related to storage of liquid hydrocarbons rather than extraction of crude petroleum. (This is similar to the situation with this application because Fukui modified powders for use in cosmetics, pharmaceuticals, coating materials, inks, paints, decoratives, fragrances, magnetic materials, and medical materials, which differs from the silver particles used in this invention to provide electrically conductive elastomers that retain their electrical properties for extended periods of time.) In *Clay*, the court also found the reference was not reasonably pertinent to the problem with which the inventor was concerned because a person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for refined petroleum by considering a reference dealing with plugging underground formation anomalies¹⁶. This is similar to the situation with this invention because one skilled in the art of providing electrically conductive elastomers would not reasonably have expected

¹² U.S. Patent 4,801,445 col. 1, lines 7-10 and lines 28-35.

¹³ Paragraph [002].

¹⁴ U.S. Patent 4,801,445 col. 1, lines 28-35.

¹⁵ *Id.* at col. 1, lines 7-10.

¹⁶ *In re Clay*, 966 F.2d 656; 23 U.S.P.Q.2d 1058 (1992) and MPEP §2141.01(a).

to solve the problem of deterioration of electrical properties over time by looking to a reference dealing with cosmetics, pharmaceuticals, coating materials, inks, paints, decoratives, fragrances, magnetic materials, and medical materials. For the reasons above, Fukui and this invention are not within the same field of endeavor and not pertinent to solving the same problem. Fukui is not properly cited because this invention and Fukui are nonanalogous.

Furthermore, obviousness is tested by what the combined teachings of the references would have suggested to one of ordinary skill in the art¹⁷. The test for obviousness is **not** whether the features of one reference may be bodily incorporated into another reference¹⁸. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination¹⁹. It is improper to use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention²⁰. A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination²¹. Additionally, it is error to find obviousness where the references teach away from the invention²². A reference should be considered for its antithetical teachings²³. In determining the differences between the prior art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious²⁴.

One skilled in the art would not be motivated to combine the disclosures of Nakayoshi and Fukui because Nakayoshi discloses a conductive adhesive comprising a conductive addition reaction-curing silicone rubber composition, which contains less than or equal to 500 ppm of low molecular weight siloxane²⁵. Examples of such a low molecular weight siloxane include cyclic dimethylpolysiloxane decamer²⁶. Fukui discloses that treatment of the powder can be effected by vapor phase treatment²⁷. The

¹⁷ *In re Fine*, 837 F.2d 1071, 1075; 1988 U.S. App. LEXIS 686; 5 U.S.P.Q.2d (BNA) 1596 (1988).

¹⁸ *In the Matter of the Application of Wood and Eversole*, 599 F.2d 1032, 1037; 1979 CCPA LEXIS 243; 202 U.S.P.Q. (BNA) 171 (1979).

¹⁹ *In re Fine*, 837 F.2d 1071, 1075; 1988 U.S. App. LEXIS 686; 5 U.S.P.Q.2d (BNA) 1596 (1988).

²⁰ *Id.* See also MPEP §2141.01 and MPEP §2145 (X)(A).

²¹ MPEP §2141.03.

²² *In re Fine*, 837 F.2d 1071, 1074; 1988 U.S. App. LEXIS 686; 5 U.S.P.Q.2d (BNA) 1596 (1988) and MPEP §2145 (X)(D) and MPEP §2143.01.

²³ *Ashland v. Delta*, 776 F.2d 281, 301; 1985 U.S. App. LEXIS 15309; 227 U.S.P.Q. (BNA) 657 (1985).

²⁴ MPEP §2141.02.

²⁵ U.S. Patent 5,173,765 col. 3, lines 19-23.

²⁶ *Id.* at col. 8, lines 15-23.

²⁷ U.S. Patent 4,801,445 col. 17, lines 1-3.

powder can be treated with, for example, hexamethyl cyclotrisiloxane²⁸ or 1,3,5,7-tetramethylcyclotetrasiloxane²⁹. One skilled in the art would recognize that hexamethyl cyclotrisiloxane and 1,3,5,7-tetramethylcyclotetrasiloxane are both siloxanes having an even lower molecular weight than cyclic dimethylpolysiloxane decamer. Therefore, Nakayoshi and Fukui teach away from each other because Nakayoshi discloses a conductive addition reaction-curing silicone rubber composition must contain less than or equal to 500 ppm of low molecular weight siloxane, and Fukui suggests purposely adding a low molecular weight siloxane in an amount that may far exceed 500 ppm. For example, Fukui discloses that the powder treated with the 1,3,5,7-tetramethylcyclotetrasiloxane can be formulated in a foundation composition³⁰. The foundation composition contains 78 weight parts of the treated powder, where the treated powder contains 1.5 weight % of the treating agent³¹. This corresponds to 12,807 ppm of the composition³².

Fukui does not teach or suggest that the modified powder would provide any benefit to a conductive addition reaction curing composition. Nakayoshi suggests that the modified powder of Fukui would be detrimental to a conductive addition reaction curing composition because the low molecular weight siloxane that can be used to modify the powder of Fukui destroys a benefit of the composition of Nakayoshi. (Example 1 and the Comparison Example³³ of Nakayoshi show that when a composition containing low molecular weight siloxanes is used, the proportion of moisture resistance defects increases as compared to when a composition that does not contain the low molecular weight siloxanes is used.) Fukui discloses that the powder treated with the 1,3,5,7-tetramethylcyclotetrasiloxane can be formulated in a foundation composition³⁴. The foundation composition contains 12,807 ppm of the 1,3,5,7-tetramethylcyclotetrasiloxane, as discussed above. Therefore, Fukui teaches away from Nakayoshi because Fukui discloses that a low molecular weight siloxane is a suitable treating agent for the powder and that the powder treated with the agent can be formulated in a composition in an amount

²⁸ Id. at col. 19, lines 60-66.

²⁹ Id. at col. 20, lines 66-67.

³⁰ Id. at col. 37, lines 50-69.

³¹ Id. at col. 20, line 56 to col. 21, line 11.

³² This amount may be calculated as follows. 20 kg of titanium dioxide was treated with 1,3,5,7-tetramethylcyclotetrasiloxane. 20.3 kg of modified powder was obtained.
 $(20.3 - 20) \text{ kg } 1,3,5,7\text{-tetramethylcyclotetrasiloxane} / 20.3 \text{ kg treated powder} \times 100 = 1.5 \text{ parts } 1,3,5,7\text{-tetramethylcyclotetrasiloxane per hundred parts the treated powder.}$

$1.5 \text{ parts } 1,3,5,7\text{-tetramethylcyclotetrasiloxane} / 100 \text{ parts treated powder} \times 78 \text{ parts powder} / (78 \text{ parts powder} + 5.5 \text{ parts 2-ethylhexyl palmitate} + 5.0 \text{ parts liquid paraffin} + 1.0 \text{ part sorbitan sesquioleate} + 0.3 \text{ part preservative} + 0.2 \text{ part perfume}) \times 10^6 \text{ part per million} = 12,807 \text{ parts } 1,3,5,7\text{-tetramethylcyclotetrasiloxane per million parts composition.}$

³³ U.S. Patent 5,173,765 at col. 9-10.

such that the composition contains far more than 500 ppm of the low molecular weight siloxane. Furthermore, Nakayoshi suggests that modifying the conductive addition reaction curing composition by adding the modified filler of Fukui would be undesirable because the modified filler has low molecular weight siloxane, which is detrimental to the composition of Nakayoshi. For the reasons above, one skilled in the art would not be motivated to add a powder treated with a treating agent of Fukui to the composition of Nakayoshi.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure³⁵.

For the reasons discussed above, there is no teaching or suggestion in the disclosures of Nakayoshi or Fukui that would motivate one skilled in the art to combine the disclosures to add the treated powder of Fukui to the composition of Nakayoshi because the disclosure of Nakayoshi suggests this would be detrimental. There is no teaching or suggestion in the disclosures of Okami and Chiba and Fukui that would motivate one skilled in the art to combine the disclosures to remove the required untreated electrically conductive fillers of Chiba or Okami and replace them with the treated powder of Fukui because neither Okami nor Chiba teaches or suggests any treated electroconductive particles. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure³⁶. Even where the combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper³⁷. The level of skill in the art cannot be relied upon to provide the suggestion to combine references³⁸. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination³⁹. A statement that modifications of the prior art to meet the

³⁴ U.S. Patent 4,801,445 at col. 37, lines 50-69.

³⁵ MPEP §2142.

³⁶ MPEP §2143.

³⁷ MPEP §2143.01.

³⁸ *Id.*

³⁹ *Id.*

claimed invention would have been “ ‘well within the ordinary skill of the art at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references⁴⁰. Therefore, the first criterion for a *prima facie* case of obviousness has not been met.

The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success⁴¹. At least some degree of predictability is required⁴². Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness⁴³. Whether an art is predictable or whether the proposed modification or combination of the prior art has a reasonable expectation of success is determined at the time the invention was made⁴⁴.

None of Chiba, Okami, and Nakayoshi in view Fukui teaches or suggests any potential benefit from adding the treated powder of Fukui to the composition of Chiba, Okami, or Nakayoshi. Furthermore, Nakayoshi suggests that adding the treated powder of Fukui to the composition of Nakayoshi would be detrimental for the reasons discussed above. Therefore, the second criterion to establish a *prima facie* case of obviousness has not been met.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art⁴⁵. All words in a claim must be considered in judging the patentability of that claim against the prior art⁴⁶. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious⁴⁷.

None of Chiba, Okami, and Nakayoshi in view Fukui and Japanese '880 discloses treating an electrically conductive filler with a silanol endblocked siloxane oligomer, such as a silanol endblocked dimethylsiloxane oligomer, a silanol endblocked dimethylsiloxane/methylvinylsiloxane co-oligomer, a silanol endblocked methylvinylsiloxane oligomer, or a silanol endblocked methylphenylsiloxane oligomer. Therefore, the third criterion for establishing a *prima facie* case of obviousness has not been met. Claims 1 and 3 are not obvious over Chiba, Okami, and Nakayoshi in view Fukui and Japanese '880. Furthermore, claims 3 and 7-15 are dependent on claim 1.

⁴⁰ Id.

⁴¹ MPEP §2143.02.

⁴² Id.

⁴³ Id.

⁴⁴ Id.

⁴⁵ MPEP §2143.03.

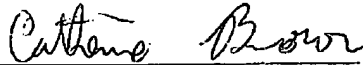
⁴⁶ Id.

⁴⁷ Id.

For the above reasons, the Applicants respectfully request that the rejection of claims 1, 2, 4, and 6 under 35 U.S.C. §103(a) over Chiba, U.S. Patent 5,384,075 to Okami, and U.S. Patent 5,173,765 to Nakayoshi in view of Fukui and Japanese '880 be withdrawn and all claims allowed to issue.

The Applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,
Dow Corning Corporation



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